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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,000	08/27/2003	Curtis W. Thornton		2109

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EXAMINER

NASH, BRIAN D

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/649,000	<b>Applicant(s)</b> THORNTON ET AL.	
	<b>Examiner</b> Brian Nash	<b>Art Unit</b> 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Specification***

2. The abstract of the disclosure is objected to because it contains such legal phrases as "said" and is written in claim format. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

***Claim Objections***

3. Claims 1-2, 4, 6 and 11 are objected to because of the following informalities: These claims are difficult to read because the separate elements are not clearly separated (see MPEP 608.01(m)[R-3]. Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation, 37 CFR 1.75(i). There may be plural indentations to further segregate subcombinations or related steps. In general, the printed patent copies will follow the format used but printing difficulties or expense may prevent the duplication of unduly complex claim formats.

It is also noted that general indentation of the claims is inconsistent between the claims, e.g. see claims 1 and 2. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Appropriate correction is required.

In claim 1, the last line is confusing in that it ends with a semicolon (;) and not a period. It is unclear whether applicant intended so claim something after “a trigger release mechanism” or if it is an inadvertent typographical error since all claims must begin with a capital letter and end with a period (.). Appropriate correction is required.

In claim 4, under action number “2)” of the “ready-to-use position”, it is not clear what “release assembly” refers to. It is believed that applicant intends for “release assembly” to be the

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“trigger release mechanism” since there is no basis for a “release assembly” and correction is required. Also in claim 4, there are numerous instances of insufficient antecedent basis for such terminology as: “the gear teeth”, “the wound or incision”, “the top surface” or “the inside top of said housing”, “the mid section”, “said anvil”, “the side legs” and “the lips”. Appropriate correction is required.

In claim 10, it is not clear what limitations are encompassed by the claim. Specifically, the claim refers to the stapler in functional terms, i.e. once an operation has occurred and it is indefinite what specific structure is further defined. Appropriate correction is required.

In claim 13, certain elements (release buttons and snap features) are similarly referred to in functional terms, i.e. once a pressing operation has occurred and it is indefinite what structural limitations are further defined with respect to the release buttons, the snap features and the handle assembly. Appropriate correction is required.

In claim 14, the snap features are referred to in terms of a condition wherein they are “forced” against a surface during another function (closing motion). It is indefinite what structural limitations are further defined with respect to the snap features and the handle assembly. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,109,844 to Becht. Insofar as the claimed invention is understood, Becht shows the invention substantially as claimed.

With respect to claim 1, Becht shows a surgical stapler having a handle assembly (2) having an actuating trigger pivotally connected via pivot screw (18); a combination staple forming mechanism and staple feeding mechanism (59,8) within a frame, the staple feeding mechanism includes a rail (49) to guide staples into a staple forming position; and a trigger release mechanism (21,94). Becht does not explicitly disclose that the surgical stapler has a disposable staple cartridge or that the staple forming mechanism utilizes a forming tool to lock the disposable staple cartridge into the handle assembly; however, Becht does disclose (see column 11, lines 5-28) that the surgical stapler may be manufactured as a non-disposable instrument enabling various parts to be replaced such as an additional supply of staples to be located on the anvil plate (7), i.e. a disposable staple cartridge. Becht further shows that when the anvil plate (7) is fully seated on the nose of the stapler that it abuts a stop surface (35), i.e. locking the cartridge into place.

It would have been an obvious matter of design choice to use either an abutting wall surface or the forming tool to lock a disposable cartridge in place for a stapling operation since applicant has not disclosed that specifically using the forming tool to lock the cartridge into place solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with either design choice.

With respect to claim 2, Becht show the handle assembly made of two mating halves (2a, 2b) having a forward portion (3) housing the staple forming and feeding mechanism (see Fig. 2);

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a pivot screw (18); a rear handle portion (2); built in guides (36,39) at the front end of the forward portion (3) for the staple forming mechanism; and built in lips (20,21) on the rear handle portion (2) interior walls proximal to the outside edges.

With respect to claim 3, Becht discloses the handle and actuating trigger portions to receive the pivot pin (18), thereby implying that these portions are detachable from one another. As discussed above, Becht also discloses that the staple cartridge may be disposable thereby making it detachable from the stapler (see column 11, lines 5-28).

***Allowable Subject Matter***

8. Claims 4-14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

With respect to claims 4, 6 and 11, the prior art of record separately shows each of elements disclosed in applicant's invention or an equivalent thereof; however, it is the examiner's opinion that it would not have been obvious to one having ordinary skill in the art at the time of the invention to combine or modify the prior art in order to arrive at applicant's invention.

Specifically, claim 4 defines such features in combination as a surgical stapler wherein the actuating trigger operates in three distinct position and wherein each of the three distinct positions are further limited by such elements as a release assembly having snap features or a forming tool engaging a window of the disposable staple cartridge thereby aligning and locking the disposable staple cartridge into an aligned position with the centerline of the stapler.

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Specifically, claim 6 defines features of the disposable staple cartridge such as having two lips built-in the cartridge housing in order to retain the staple at the front in combination with an end cap assembled to a rail of the stapler via two cantilever snaps at the back end of the cartridge housing that provide an engagement means to the handle housing.

Specifically, claim 11 defines structure of the trigger release mechanism having a leaf spring, two latches with snap features made of a resilient material and two release buttons.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Becht et al., Giersch et al., Campbell et al., Thornton, Smith et al., Peters et al., Ruckdeschel et al., Kraus et al., Izuchukwu et al. and Fung et al. are cited to show related references.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Nash whose telephone number is 571-272-4465. The examiner can normally be reached on Monday – Thursday from 8 a.m. to 6 p.m.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached at 571-272-4467. The official fax number for this

Group is: 571-273-8300



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12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12/19/2005

A handwritten signature in black ink, appearing to read 'Brian Nash', with a long horizontal line extending to the right.

Brian Nash  
Patent Examiner  
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